

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/919,747
Inventor: Joseph C. Murray
Filing Date: 08/01/2001
Title: Insulating Packaging Material and
Related Packaging System
Art Unit: 3728
Examiner: Luan K. Bui

VIA EFS

Mail Stop Petition

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTN: EXAMINER THURMAN PAGE

**REQUEST FOR RECONSIDERATION AND RENEWED PETITION TO
REVIVE UNINTENTIONALLY ABANDONED APPLICATION UNDER 37 CFR
§ 1.137(b) AND MPEP § 711.03(c)**

I. Introduction

In response to the Office's Decision on Petition of November 24, 2008 concerning the above-captioned U.S. Patent Application, (09/919,747, "the '747 application"), the Applicant Mr. Joseph Murray ("Mr. Murray" or "Applicant") and Assignee ThermaFreeze Products Corporation ("ThermaFreeze" or "Assignee", of which Mr. Murray is President), hereby request reconsideration of the Decision and again request the revival of the '747 application. The instant response is believed to be fully responsive to all of the points raised in the Decision. **The entire delay in responding to the February 7, 2005 Office Action was unintentional.** A check in the amount of \$770 was enclosed with the original petition, and it is believed no additional petition fees are necessary at this time. Applicant hereby petitions for a **one month** extension of time under 37 CFR § 1.136(a) to extend the response deadline from January 24, 2009 to **February 24, 2009**. Please charge the small entity one month extension of time fee of

\$65 (Fee Code 2251) to the undersigned's Deposit Account, No. **50-0932**. If any additional fees are required to maintain this petition, or if an overpayment has occurred, please charge/credit same to the undersigned's Deposit Account, No. **50-0932**.

In comparing the Office's November 24, 2008 Decision and the August 1, 2008 Decision, Applicant and the undersigned noticed two things: a) that the two Decisions were substantially similar, and b) that the sentence atop page 3 of the second Decision reads "The renewed petition filed October 20, 2008 **does** explain what effort(s) was made to further reply to the outstanding Office action and, further, why no reply was filed." (Emphasis added.) The undersigned and Assignee were confused; if the renewed petition did so explain, then why was the petition dismissed again?

Seeking clarification, the undersigned telephoned the Examiner, Thurman Page on December 9, 2008, and left a message. Mr. Page called the undersigned back on December 11, 2008, and the two spoke at some length. Assignee and the undersigned *greatly* appreciate Mr. Page taking the time to discuss the petition. The basic gist of the discussion is that the Office was seeking additional documentary evidence to corroborate the statements made in support of the petition, as well as what steps were taken to attempt to contact former attorney Pugh and determine his condition and knowledge of the facts surrounding the abandonment of the '747 application. The instant papers are believed to supply sufficient documentation and statements to support the petition.

First, Mr. Murray is herewith providing all of his medical records to corroborate his statements of his extreme infirmity from 2002-2006. Second, Mr. Murray and the undersigned are providing additional documentation and statement that shows that a)

several attempts were made to contact Pugh, all rebuffed, and b) a very recent conversation between Mr. Murray and Mr. and Mrs. Pugh reveals that Mr. Pugh cannot and will not be able to assist in this inquiry whatsoever. Similar to the filing of an application without the cooperation of an inventor under 37 CFR § 1.47, Assignee and the undersigned have made every reasonable attempt to contact Pugh and discover the facts surrounding the abandonment. Because Pugh is unable (and his caregiver wife is unwilling) to help, the Office simply must accept the statements made without Pugh's corroboration.

Third, Applicant and Assignee reiterate their position and answers each point raised by the Office in its two Decisions. Applicant and Assignee had absolutely no intention to delay responding to the outstanding Office Action of February 7, 2005 –and, indeed, had no knowledge whatsoever of that Office Action– during Period (1) or Period (2) identified in the Decision on Petition. The inventor and president of Assignee ThermaFreeze, Joseph Murray, was never, at any point, informed by Mr. Pugh (the then-responsible patent attorney) that there was any correspondence at all from the PTO for the '747 application, let alone the February 7, 2005 Office Action. As such, there was absolutely no way for Mr. Murray or ThermaFreeze to have done or considered to do anything at all about Mr. Pugh's failing to respond to this Office Action. The Applicant only first became aware the application had been abandoned even once on September 28, 2007 when his current attorneys (the undersigned) informed him as such. Indeed, the undersigned informed Applicant that the '747 application had been abandoned three times (failure to respond timely to a Notice to File Missing Parts of 2001; failure to

respond timely to Restriction Requirement of July 2003; and failure to respond to the February 2005 Office Action) on September 28, 2007, to which Applicant responded with stunned surprise and silence.

Regarding Period (1), the Office has requested that Mr. Pugh explain why the application became abandoned, when Mr. Pugh became aware of the abandonment of the application, what efforts he made to respond to the Office Action, and with whom the matter was discussed. The Office points out that the record is unclear concerning intent prior to the abandonment date. Alternatively, if Mr. Pugh cannot answer, Applicant is requested to explain “why this application became abandoned and what efforts were made to further reply and with whom the matter was discussed.”

Mr. Pugh is unavailable, on several levels. As Applicant has already indicated, Mr. Pugh is completely incapacitated, and he cannot answer any of these questions to any degree, let alone to anyone's satisfaction. Also, his wife has moved him away to aid in his recovery, and his location is now unknown and he is completely unreachable. **Pugh's contact information has to this day not been updated, not on his website patentlaw.com, nor with the PTO's Office of Enrollment and Discipline.**

Additionally, he appears to have been a solo practitioner since 2004 and appears not to have had a secretary at the time.

As to intent, Applicant has stated before and does so again with more particularity below and in a second Supplemental Declaration that it was always his intention and his company's intention to maintain the '747 application and to respond to any issues raised by the Office. The inventor, Joseph Murray, had on multiple occasions prior to and

cotemporaneously with the 2005 Office Action instructed Mr. Pugh to maintain the '747 application. Applicant was the ultimate decider as to whether to continue to prosecute a patent application or not; Mr. Pugh was merely Applicant's representative to the Office and was supposed to carry out Applicant's wishes and instructions. Mr. Pugh failed to do so for this application, and actually allowed it to go abandoned on three separate occasions without informing Mr. Murray either that any correspondence had come from the Office or that he had failed to respond to same. There was no way for Mr. Murray to know nor to suspect that Mr. Pugh was not maintaining the '747 application as he was instructed to do.

Regarding Period (2), the Office requires an explanation as to why Applicant "waited for more than a year after learning of Pugh's limitations" to seek new counsel.

Only a few months elapsed after even initially learning of Mr. Pugh's health problems before Assignee and Mr. Murray were seeking new counsel. Applicant had no idea that Mr. Pugh was permanently incapacitated for quite some time; in fact that knowledge was not confirmed until November 2007, months after new counsel had already been retained. Also, Applicant did not know that an Office Action had even been mailed in 2005 until new counsel told him so in late September 2007. No great haste in the search for new counsel was indicated, since it was believed generally that the patent portfolio had been maintained, and specifically that no Office Action had been mailed prior to Mr. Pugh's strokes. This was not a case of a deliberate action on the part of Applicant to allow the application to go abandoned. Rather, it was a case of an Applicant

reasonably relying on his patent attorney to maintain and prosecute an application pursuant to Applicant's standing and repeated instruction, with the latter failing to do so.

II. Facts that Further Support Applicant's Assertion Of Its Intention To Maintain '747 Patent Application

A. Time Period Leading Up To Abandonment

During 2002-2005, as mentioned in the initial Petition, Applicant was extremely ill, yet he still kept in contact with Mr. Pugh periodically. (Second Supplemental Declaration of Joseph C. Murray, hereinafter "2nd Supp'l Murray Dec.", at ¶ 4 and Exhibits A and B thereto.) Mr. Murray always instructed Mr. Pugh to maintain the '747 application. (Id.) **Evidence of Mr. Murray's illness in the form of Mr. Murray's complete medical records appears in Exhibits A and B attached to the Second Supplemental Declaration.** Mr. Murray sent a number of e-mails to Mr. Pugh with instructions to maintain the '747 patent application and the rest of the patent portfolio, and received back from Mr. Pugh acknowledgement of same. (Id.) For example, during that period, Mr. Murray sent and received a number of e-mails to and from Mr. Pugh to this effect, which included the explicit instructions to pay the maintenance fee on U.S. Patent No. 5,628,845 ("the '845 patent"). (Id.) Mr. Murray also had payment sent to Mr. Pugh for the maintenance fees for the '845 patent and U.S. Patent No. 5,966,962 ("the '962 patent"). (Id.) Unfortunately, Mr. Murray's records of these e-mails were destroyed as a result of Hurricane Katrina in 2005. (Id.)

Both via e-mail and over the telephone, Mr. Pugh assured Mr. Murray that he would work on the '747 application when the time came. (Id.) Mr. Murray was never

informed that the Office had sent any correspondence to Mr. Pugh concerning the '747 application. (Id.) Mr. Murray thought that, by expressly instructing Mr. Pugh not to abandon the '747 application, if the Patent Office asked for additional documentation or information, he would be informed. (Id.)

Mr. Pugh never mentioned to Mr. Murray or anyone else at Assignee company that he had received an Office Action or any other such communication from the Patent Office. (2nd Supp'l Murray Dec. at ¶ 5.) As explained in detail in the initial Petition, it was only on September 28, 2007 that Mr. Murray became aware there even was a 2005 Office Action, and it was the undersigned who told him so. Mr. Murray and Assignee company were completely unaware of any of the three abandonments of the '747 application until September 28, 2007. (Id.)

Around the time of the '747 application's abandonment in May of 2005, Mr. Murray underwent his second major surgery in which a baseball-sized tumor and 20% of his liver were removed. (2nd Supp'l Murray Dec. at ¶ 6 and Exhibits A and B thereto.) During the rest of 2005 and the first portion of 2006, he underwent very extensive chemotherapy. (Id.) At some point during that period, he inquired of Mr. Pugh as to the status of the '747 application. (Id.) Mr. Pugh reassured Mr. Murray that everything was being taken care of and in order. (Id.) He had no way of knowing that that statement was inaccurate. Mr. Pugh never mentioned to Mr. Murray that the Patent Office had examined the '747 application. (Id.) All of the correspondence from the Patent Office went to Mr. Pugh; none of it went to Applicant, Assignee, or anyone else. (Id.) No one but Mr. Pugh knew what was going on with the '747 application, and Mr. Pugh never

told Mr. Murray. (Id.) To this day, Mr. Murray has no idea why Mr. Pugh let it go abandoned despite Mr. Murray's instructions and intentions to the contrary. (Id.) Additionally, with the 2004 death of Tom Pryor, Mr. Murray's business partner, there was no one else available with whom Mr. Pugh could have corresponded or who could have checked up on Mr. Pugh and the patent portfolio. (Orig. Murray Dec. of December 18, 2007 at ¶ 14.)

Thus, from the filing of the '747 application up until and beyond its improper abandonment by Mr. Pugh, Mr. Murray and his company fully intended to maintain the '747 application and not to allow it to go abandoned, and they did everything in their power to do so.

B. Re-energizing the Business and Replacing Mr. Pugh as Patent Counsel: June 2006 - July 2007

Shortly after being diagnosed as cancer-free on June 6, 2006 --still completely unaware the '747 application had been examined and abandoned-- Mr. Murray began to re-assume the duties and responsibilities of attempting to commercialize his inventions almost at once. (2nd Supp'l Dec. at ¶ 9.) As part of revitalizing the company, Mr. Murray had the responsibility to refurbish an 18,000 square foot building, including completely replacing the roof. (Id.) He also had to oversee --and sometimes personally physically accomplish-- the moving of production equipment, office furniture and equipment, etc. into the new facility. (Id.) During the period of June 2006 through July 2007, he was hard at work rebuilding his business, sometimes working 18 hours a day, often seven days a week in this regard.

As mentioned in the previous Petition, when Mr. Murray telephoned Mr. Pugh to determine the status of the '747 application in June 2006, Mr. Pugh suffered a major debilitating stroke while they were speaking on the telephone. (Supp'l Murray Dec. at ¶ 10.) After that telephone call, over the course of the next several months, Mr. Murray made numerous attempts to try to reach Mr. Pugh. (2nd Supp'l Murray Dec. at ¶ 11.) On one occasion, Mr. Murray spoke with Mrs. Pugh, who indicated that Mr. Pugh was not well, that he actually had suffered a second major stroke on the other side of his brain. (Id.) On at least one subsequent occasion, Mr. Murray was able to reach Mr. Pugh directly. (Id.) In none of those post-stroke telephone conversations was Mr. Pugh coherent nor did Mr. Pugh make any sense. (Id.)

For several months after July 2006, Mr. Murray did not know if Pugh would recover sufficiently to return to work, and he had all the files and records. (2nd Supp'l Murray Dec. at ¶12.) Mr. Murray still did not know of any outstanding office actions at this point. As time went on, he called the Pugh home/office every two to four weeks for the next year, i.e., until June 2007. (2nd Supp'l Murray Dec. at ¶ 13.) Those calls were placed at all times of the day and evening, yet no one returned his messages. (Id.) Since Mr. Pugh's previous partner had died several years earlier (see Supp'l Negrin Dec. at ¶ 4 and Ex. B), and since no one else was in the office when Mr. Pugh had a stroke while on the phone with Mr. Murray (2nd Supp'l Murray Dec. at ¶ 18) or any time thereafter, there was and is no one else to try to contact about Mr. Pugh's files.

At the end of 2006, only a few short months after the fateful phone call with Mr. Pugh, it became clear to Mr. Murray that he needed to find new patent counsel, even

though he still did not know about the 2005 Office Action. (2nd Supp'l Murray Dec. at ¶ 15.) He began his search locally in Mobile, AL. (Id.) As time went on, he widened his search for a patent attorney to Birmingham and Atlanta, although the fees for firms in these areas were much larger than Pugh's. (Id.) Mr. Murray understood the seriousness of the situation, yet without knowing that the application had been examined and abandoned already, there was no reason for him not to search for new patent counsel methodically and carefully. Mr. Murray and Assignee had spent a tremendous amount of money on the patent portfolio, and they wanted to ensure that their next patent attorneys would be the right fit for them. (2nd Suppl. Murray Dec. at ¶ 15.) They had no idea at that point that the portfolio was already in jeopardy. (Id.)

From the end of winter and towards the end of the spring of 2007, Mr. Murray realized his company needed to reorganize and recapitalize. (2nd Supp'l Murray Dec. at ¶ 16.) During the early summer of 2007, current counsel and the undersigned were retained for these purposes. (Id.) The decision was made not to look further for other patent attorneys since Pryor Cashman also has patent attorneys. (Id.)

Thus, from the time of the fateful June 2006 telephone conversation between Mr. Murray and Mr. Pugh until new patent counsel was retained, Applicant and Assignee fully intended to maintain the '747 application and not to allow it to go abandoned.

The details of the interaction between current counsel and Mr. Murray appear in the previous Declaration and are not at issue. Clearly, the abandonment and all of the delay in responding to the February 2005 Office Action were unintentional. As soon as

the abandonment was discovered, Applicant acted quickly and instructed his new attorneys to act to revive the application.

III. Argument: Applicant Was As Diligent As Possible from the Time the '747 Application Went Abandoned Until the Petition Was Filed, and the Office Is Required to Accept Applicant's Statement to That Effect As True

A. The Unintentional Standard Is Lower Than The Unavoidable Standard

A former Commissioner of Patents spelled out the underlying standards of reviving an expired patent application in *In re Katrapat*, 6 USPQ2d 1863 (Comm'r Pat. & Trademarks 1988):

[The word "unavoidable"] is applicable to ordinary human affairs, and requires no more or greater care than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Katrapat, 6 USPQ2d at 1866 (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat 1887)). This statement was made in connection with unavoidable abandonment of an application, a much higher standard than the unintentional standard under which the instant petition is sought. Yet even under the unavoidable standard, it is still taken into account that, to put it bluntly, things happen, and that no one performs his or her duties completely free from error or without incident. It was entirely reasonable for Applicant to rely on Mr. Pugh --a seemingly and previously "worthy and reliable"

registered patent attorney who had drafted and filed the '747 application-- for maintaining and prosecuting the '747 application.

B. The Office Must Rely on Applicant's Statements Made in Support of A Petition to Revive An Abandoned Application

Additionally, the Office has acknowledged on multiple occasions that it must rely on the truthfulness of the statements made by Applicants seeking to revive an abandoned application. For example, the Office wrote in the Federal Register in announcing the addition of the unintentional standard under § 1.137(b):

While it is possible for an applicant to make a misleading statement that the delay was unintentional to obtain revival of an abandoned application, the Office simply must rely upon the candor and good faith of those prosecuting patent applications (e.g., it is equally possible for a party to fabricate evidence and obtain the revival of a long-abandoned application on the basis of unavoidable delay). Any applicant obtaining revival based upon a misleading statement that the delay was unintentional may find the achievement short-lived as a result of the question of intentional delay being raised by third parties challenging any patent issuing from the application.

62 FR 53162 (October 10, 1997), emphasis added. The Office reiterated this position in the Official Gazette of the Patent Office in its August 31, 1999 edition:

The PTO relies upon the applicant's duty of candor and good faith and usually accepts the statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional" without requiring further information in the vast majority of petitions under 37 CFR 1.137(b). This is because the party presenting a paper is obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when the party provides this statement to the PTO....

Off. Gaz. Pat. Office, August 31, 1999, now codified verbatim in MPEP

§711.03(c)(II)(C) (Rev. 6, at 700-191).

Thus, in the vast majority of petitions to revive filed under the unintentional standard, the Office simply accepts the applicant's statement that the entire delay was unintentional. The form to file for such a petition is remarkably short, and the "entire delay" statement that appears on the form is literally one sentence long. This one sentence is sufficient for the "vast majority" of cases.

There are some cases --the very small minority-- where this single sentence is insufficient. However, in those cases:

Even if the PTO requires further information in a petition under 37 CFR 1.137(b), the petition under 37 CFR 1.137(b) is significantly less burdensome to prepare and prosecute than a petition under 37 CFR 1.137(a). **The PTO is almost always satisfied that "the entire delay...was unintentional" on the basis of statement(s) by the applicant or representative explaining the cause of the delay** (accompanied at most by copies of correspondence relevant to the period of delay).

Off. Gaz. Pat. Office, August 31, 1999, emphasis added (now codified nearly verbatim in MPEP §711.03(c)(II)(C) (Rev. 6, at 700-191)).

In the instant case, Mr. Murray, president of Assignee and the inventor, states in a Declaration that he repeatedly discussed his wish to continue prosecuting the '747 application with Mr. Pugh his patent attorney, both verbally and in writing. (2nd Supp'l Murray Dec. at ¶¶ 4 and 6.) That the correspondence evidencing same has since been destroyed by a random lightning strike is unfortunate, however its absence is not a bar to accepting Mr. Murray's statements as factual and true. Indeed, the Office is required to do so. Further, it is not clear why the Office thought Mr. Murray might be fabricating the

facts concerning his extremely poor health during the period in question. Nevertheless, Mr. Murray has been able to obtain records from the institutions that provided surgery and chemotherapy, and they are attached to his Supplemental Declaration. (2nd Supp'l Murray Dec. at ¶ 4; Exhibits A and B.)

It is not clear if the Office is also seeking medical records of Mr. Pugh. If so, those are unavailable; the Privacy Rule of the Health Insurance Portability and Accountability Act (HIPAA) prohibits the disclosure of an individual's personal health information to all but the individual, his treating physicians, and relevant associated parties. See, e.g., 45 CFR Parts 160 and 164. The USPTO is not, by any stretch of the imagination, a relevant associated party, and Mr. Murray and Assignee ThermoFreeze certainly are not either. Mrs. Pugh, Mr. Pugh's caregiver, has been extremely unresponsive to requests for the most minimal of contact, and understandably so. She is far too busy taking care of her incapacitated husband even to continue working herself, let alone to worry about quaternary matters (to her) such as these. (2nd Murray Supp'l Dec. at ¶ 17.) Indeed, both Mr. Murray and the undersigned have made multiple attempts to contact the Pughs, including voice messages, faxes, conventional mailings, and an unannounced in-person visit, with essentially zero substantive response. (2nd Supp'l Negrin Dec. at ¶¶ 4 and 6; 2nd Supp'l Murray Dec. at ¶¶ 8, 11, and 13.)

Even so, statements by more than one witness have been provided to attest to the status of Mr. Pugh. Mr. McGuire previously submitted a Declaration which stated that he went to Mr. Pugh's home office and found him to be extremely incapacitated, nearly a vegetable. Mr. Murray's initial Declaration attests to the same facts in discussing

telephone conversations Mr. Murray attempted to have with Mr. Pugh after the fateful June 2006 telephone call. Also, Mr. Murray's Second Supplemental Declaration filed herewith describes a very recent conversation (December 2008) with Mr. Pugh in which Mr. Pugh has made very little progress and has no recollection of the work he did for Mr. Murray or Assignee. (2nd Supp'l Murray Dec. at ¶¶ 18-19.) Mr. Pugh said to Mr. Murray: "I know that I must have done work for you or your company but I can't remember anything I did for you." (Id.) **There is no possibility of recovering any relevant information from Pugh at this point.**

C. Applicant Has Shown That The Delay Was Unintentional and That Former Counsel Mr. Pugh Is Totally Unavailable

Applying the unintentional standard outlined above (not the more stringent unavoidable standard) to Applicant's petition, it is respectfully submitted that the original petition already went well beyond the usually sufficient single sentence statement that the entire delay was unintentional. Applicant has, rather comprehensively, explained the cause of the delay, and has provided as much documentation as exists, thereby satisfying the requirements under MPEP § 711.03(c)(II)(C). Applicant has declared, under penalty of perjury and invalidity of any to-issue patent, to a great many facts, including the following:

- he took the reasonable and prudent step of hiring a patent attorney to write and prosecute the '747 application;
- he had instructed the patent attorney repeatedly to prosecute and maintain the '747 application, and the attorney indicated that he would;

- he never had any intention of letting the '747 application go abandoned, and he never expressed any such intention to abandon to his attorney; and

- he was never informed by his patent attorney of the February 7, 2005 Office Action, and did not learn of it until September 28, 2007 from the undersigned.

The Office has cited three judicial opinions for the proposition that “it is pointless for the USPTO to revive a long abandoned application without an adequate showing that the delay did not result from a deliberate course of action.” (Decision at 3.) Applicant’s Petition and the facts supporting same pass muster under all three opinions, as explained in the previous Request for Reconsideration at pages 12-13, which explanation is renewed and incorporated by reference and considered to be set forth herein.

From the facts presented above, and those presented in the original Petition, it is clear that **Mr. Murray never had any intention of allowing the ‘747 application to go abandoned, not in 2005, nor at any point since then.** Mr. Murray hired Mr. Pugh to prosecute his patent applications and instructed him to pay the maintenance fees for other issued patents, and Mr. Pugh failed to do so, although he advised Mr. Murray that he had. There was no reason for Mr. Murray to doubt Mr. Pugh or assume that Mr. Pugh was not doing the job he was tasked to do; indeed, Mr. Pugh’s credentials were impressive (see previous Negrin Dec. Exhibit A), and he had successfully written three patent applications for Mr. Murray. Mr. Pugh was a registered patent attorney, and Mr. Murray relied on Mr. Pugh for, among other things, prosecuting the ‘747 application. Mr. Pugh failed to do so.

As it turns out, Mr. Pugh failed to do a lot things in the course of representing Mr.

Murray and prosecuting the patent portfolio. He failed to pay the 3 ½ year and 7 ½ year maintenance fees for the '962 patent; he failed to pay the 7 ½ year fee for the '845 patent; and he failed to pay the 3 ½ year fee for the '189 patent. And, of course, he allowed the instant '747 application to go abandoned on *three separate occasions* by not filing timely responses to a Notice to File Missing Parts, a Restriction Requirement, and a first Office Action, all in contradiction of Applicant/Assignee's express instructions. (Negrin Dec. at ¶ 5 and Exhibit B thereto.) Only in retrospect, it appears that something was wrong with Mr. Pugh, perhaps a decline in health that manifested itself in forgetfulness or carelessness. Unfortunately, there was no one else in his office to pick up the slack, as he appears to have been a sole practitioner since at least 2004. (See, e.g., Negrin Dec. Ex. A.) There was also no way to tell at the time of the abandonment that something was amiss with Mr. Pugh.

Even if there were some external evidence of something going awry with Mr. Pugh, Mr. Murray was in no position to take significant steps to check up on the previously reliable patent attorney whom he trusted. As now corroborated by his medical records, Mr. Murray was, literally, deathly ill from cancer for nearly the entire period of time the patent application had been abandoned and the other patents expired until his fateful phone call to Mr. Pugh on June 2006. After losing substantive contact with Mr. Pugh following June 2006, Mr. Murray was hard at work rebuilding his company, and still he had no idea that an Office Action had been mailed a year earlier, let alone that it was unanswered and that the application had become abandoned.

Additionally, as uncontrovertibly proven with the submissions herewith, Mr.

Murray and ThermaFreeze had (after June 2006) and still have no way of reaching Mr. Pugh. All of Pugh's contact information remains unchanged since 2004, both on his website and with the USPTO. That contact information has proven useless. Further, a very recent conversation with Mr. Pugh (initiated by Mrs. Pugh) revealed that further attempts to make contact with would be equally useless: the man has no recollection of anything relevant to this petition or to Applicant/Assignee at all. That route is a dead end.

Mr. Murray is, quite frankly, lucky to be alive, luckier still to be able to work and attempt to commercialize the inventions and the ThermaFreeze patent portfolio. It would not have been reasonable for Mr. Murray --while enduring the trials of surgery, chemotherapy, and radiation therapy-- to be expected to maintain sufficiently close contact with his patent attorney over 1300 miles away to make sure Mr. Pugh was doing what he was repeatedly instructed to do. Indeed, even a perfectly healthy client would have had no indication something was wrong and thus no motivation to follow up, especially in light of Mr. Pugh's repeated assurances. Further, given that the Office does "not engage in double correspondence with an applicant and a patent practitioner" (37 CFR § 1.33(a)), there is no way Mr. Murray would have been able to be informed of the 2005 Office Action other than from Mr. Pugh.

D. All Office Questions Have Been Answered As Best As Possible

Each and every point raised by the Office's Decisions is addressed either above or in previous submissions, and each and every Office question has been answered. What

follows is an accounting of those points and questions, and the corresponding answers.

1. *“The renewed petition filed October 20, 2008 does explain what effort(s) was made to further reply to the outstanding Office action and, further, why no reply was filed.”* (October 20, 2008 Decision, Page 3, lines 1-2.)

Applicant agrees with this statement. Should this sentence have been meant to read “...does not explain...”, then Applicant offers the following. The Office Action went to Mr. Pugh, who did not tell Applicant about it at all. The Office does not engage in double correspondence, so there was no way for Applicant or Assignee to learn of the Office Action other than through Mr. Pugh. Despite Applicant’s direct instructions to the contrary, Mr. Pugh let the application go abandoned, and he subsequently had a debilitating series of strokes which then and now prevent him from answering any questions about why he let the ‘747 application go abandoned. Within a few months of Mr. Pugh’s first major stroke and subsequent ‘radio silence’, Applicant and Assignee began looking for new attorneys, unaware that there had been an Office Action until September 28, 2007. As soon as they found out about the Office Action, they authorized the undersigned to prepare and file a response and the instant petition to revive the application. They acted as quickly as possible.

These facts are the opposite of the facts in all of the legal opinions cited by the Office in its Decisions. In all of those opinions, the attorney did inform the applicant about the existence of an Office Action, and in all of those decisions, the applicant either ignored the attorney or instructed the attorney not to proceed, only to petition later after a change of heart. By contrast, Pugh did not inform Applicant about the Office Action, and

Applicant had continually instructed Pugh not to abandon the '747 application but rather affirmatively told him to maintain the '747 application.

2. *"If no effort was made to further reply, then the person responsible must explain why the delay in this application does not result from a deliberate course of action (or inaction)."* (October 20, 2008 Decision, Page 3, lines 2-4.)

The person responsible *for making decisions* about the '747 application was and is Mr. Murray, who hired Mr. Pugh to represent his company's interests before the Office. The Office's contact person for this application was Mr. Pugh. For reasons unknown and now unknowable, Mr. Pugh failed to report the Office Action (or a previous Notice to File Missing Parts, or a previous Restriction Requirement) to Mr. Murray. Mr. Murray has already explained it was never his intention to abandon this application (Murray Dec. of December 18, 2007 at ¶ 2; Supp'l Murray Dec. of October 17, 2008 at ¶¶ 2 and 4; 2nd Supp'l Murray Dec. of February 20, 2009 at ¶¶ 2 and 4) and that, to the contrary, he had always affirmatively instructed Pugh to maintain the '747 application (Supp'l Murray Dec. of October 17, 2008 at ¶ 4; 2nd Supp'l Murray Dec. of February 20, 2009 at ¶ 4). With the 2004 death of Tom Pryor, Mr. Murray's business partner (original Murray Dec. at ¶ 14), no one else was available to try to follow up with Pugh, even if there were justification to do so.

3. *As C. Emmett Pugh (Pugh) was the party having the right to reply at the date of abandonment, Pugh should explain, to the extent that his infirmities will permit, why this application became abandoned while it was under his control and what efforts he made to further reply and with*

whom the matter was discussed. When did Pugh become aware of the abandonment of this application?

(October 20, 2008 Decision, Page 3, lines 4-8.)

Pugh cannot answer anything at all about this or any other application. Applicant has already submitted the statement under penalty of perjury of Bob McGuire that he personally drove up to Pugh's home in November 2007 and found him substantially incoherent. (McGuire Dec. of Nov. 15, 2007 at ¶¶ 5-6.) Mr. McGuire also said Mrs. Pugh had no information about any of Mr. Pugh's files. (Id.) Applicant also has already submitted the statement under penalty of perjury of Mr. Murray, the inventor and the president of the Assignee, that Mr. Pugh was not coherent over the telephone in 2006. (Murray Dec. of December 18, 2007 at ¶ 19.) Applicant submits herewith the statement under penalty of perjury of Mr. Murray that he spoke briefly with Pugh in December 2008, and that Pugh had no recollection of any work he did for Mr. Murray. (2nd Suppl. Murray Dec. February 20, 2009, at ¶ 19.) Finally, even if Mr. Pugh had something relevant to say, there is no way to contact Mr. Pugh, as all of the contact numbers and addresses listed on his website and in the PTO database are the same numbers and addresses that Applicant and the undersigned have been using for the past 1 ½ years. Mrs. Pugh has moved her husband somewhere, and no one related to the '747 application has any idea of how to reach her or him.

4. *"[T]he record does not show with substantiating evidence what the intent was with regard to this application prior to the date of abandonment on May 8, 2005."*

(October 20, 2008 Decision, Page 3, lines 9-11.)

Mr. Murray has already indicated under penalty of perjury that he and ThermaFreeze never had any intention of letting the '747 application go abandoned. Further, there had been correspondence between Mr. Murray and Mr. Pugh to that effect, however the record of such correspondence was kept on a computer that has since been destroyed in a lightning strike associated with Hurricane Katrina in 2005. (Supp'l Murray Dec. at ¶ 4; 2nd Supp'l Murray Dec. at ¶ 4.) The very detailed statements of Mr. Murray are substantiating evidence. It would be nice if documentary evidence were available, however Mr. Pugh's files (and Mr. Pugh himself) are missing and Mr. Murray's files were destroyed.

5. "Copies of any correspondence relating to the filing, or to not filing a further reply to the outstanding Office action are required from responsible person(s), petitioner, and whoever else was involved with this application at the time of the abandonment."
(October 20, 2008 Decision, Page 3, lines 12-14.)

As mentioned above, all of Mr. Murray's correspondence has been destroyed, and none of Mr. Pugh's files are available. Mr. Murray and Assignee had no idea there even was an Office Action until the undersigned told them so in September 2007. None of the case law cited by the Office or any case law at all concerning unintentional abandonment requires the submission of correspondence. By contrast, the Office has stated in the Federal Register and the MPEP that it must rely on the statements submitted by applicants and the candor and good faith of those applicants. 62 FR 53162 (October 10, 1997); Off. Gaz. Pat. Office, August 31, 1999, now in MPEP § 711.03(c)(II)(C) (Rev. 6,

at 700-191.)

6. “*Statements are required from person(s) in the law office and, if possible, the responsible person(s) having firsthand knowledge of the circumstances surrounding the lack of a reply to the outstanding Office action.*” (October 20, 2008 Decision, Page 3, lines 14-16.)

Mr. Pugh was the only person in his law office. No one else has appeared on his website since his partner Mr. Ambrose died in 2004. (Negrin Dec. of December 18, 2007 at ¶ 2 and Exhibit A thereto; Supp’l Negrin Dec. of February 19, 2009 at ¶ 5 and Exhibit C attached thereto.) He did not even have a secretary, which is why he was alone when Mr. Murray spoke to him when he had his first debilitating stroke (2nd Supp’l Murray Dec. at ¶ 18.) The only remaining person for making decisions about the ‘747 application is Mr. Murray, and he has provided very detailed statements as to the circumstances surrounding the lack of a reply to the Office Action (e.g., his attorney never told him about it, and he filed the instant petition within three months of finding out).

7. “*As the courts have made clear, it is pointless for the USPTO to revive a long abandoned application without an adequate showing that the delay did not result from a deliberate course of action.*” (October 20, 2008 Decision, Page 3, lines 16-18.)

As has been previously pointed out to the Office (see previous Request for Reconsideration submitted October 21, 2008 at pages 12-13), the cases cited by the

Office all deny revival because there was documentation that **contradicted** the statements of unintentionality. Here, there are no documents that contradict Applicant's position, only documents that support it. Further, in all of the cases cited, the respective attorneys **had properly notified their clients** about the Office Action that went unanswered. Here, Mr. Pugh failed to notify Mr. Murray or Assignee about the February 2005 Office Action. The instant fact pattern is wholly different from those of the cases cited by the Office in its Decisions. As such, reliance on those cited cases is misplaced, and denial of the instant petition is improper.

8. *"Statements are required from persons in the law office and, if possible, the responsible person(s) having firsthand knowledge of the circumstances surrounding the protracted delay, after the abandonment date, in seeking revival...."* (October 20, 2008 Decision, Page 4, lines 16-27.)

Applicant respectfully disagrees with the characterization that the delay in seeking revival was protracted. By any calculus, Mr. Murray and Assignee's response was timely. First, Mr. Murray did not even learn of the Office Action and the abandonment until September 28, 2007. (Negrin Dec. at ¶ 5; Murray Dec. at ¶ 24.) The initial petition was filed December 21, 2007, less than three months later.

Second, the Office takes issue with the time period between June 2006 when Mr. Murray "became aware of Pugh's infirmities and difficulty in remaining coherent" and July 2007 when new counsel was retained. According to the Office, "[t]he record does not explain why Murray and ThermaFreeze Products Corporation waited for more than a

year after learning of Pugh's limitations to ensure that the instant application was managed properly." Applicant respectfully submits that it did not "wait for more than a year." The Office is incorrect in saying that Applicant learned of Pugh's limitations in June 2006. Mr. Murray learned that Pugh had had a stroke in June 2006, but there was no indication of the extent of the stroke or how long the damage would last until much later. It took several months of telephone calls to the Pughs to learn even the extent of the damage of the stroke (but not the permanence of same). (Murray Dec. at ¶ 19; Supp'l Murray Dec. at ¶¶ 11-13.) In fact, shortly thereafter, at the end of 2006 (less than six months after the initial fateful phone call), Mr. Murray and ThermaFreeze did start looking for new patent counsel. (Supp'l Murray Dec. at ¶ 15; 2nd Supp'l Murray Dec. at ¶ 15.) Because they were still unaware there was an outstanding Office Action, they conducted their search for new counsel methodically. Patent counsel are not fungible goods, like hammers or bottles of soda. One does not jump headlong into an attorney-client relationship, especially if one is wholly unaware that one already has a problem (i.e., the abandonment). Mr. Murray says it best in his Second Supplemental Declaration filed herewith:

"We had spent a tremendous amount of money on the patent portfolio, and we wanted to ensure that our next patent attorneys would be the right fit for us. So we conducted our search for new counsel methodically, wholly unaware that our portfolio was already in jeopardy.
(2nd Supp'l Murray Dec. at ¶ 15.)

IV. Conclusion

It is believed that Applicant and Assignee have fully demonstrated that they never intended to allow the '747 application to go abandoned. They did what they were supposed to do --hire a registered patent attorney to represent their interests and carry out their instructions. That attorney failed to do so. Penalizing Applicant/Assignee for their previous attorney's failure here would be unreasonable. Reconsideration is therefore respectfully requested.

Should the Office require any additional information, the Office is earnestly invited to contact the undersigned telephonically or via e-mail, facsimile, or any other means prior to dismissing or denying the petition or the instant request for reconsideration.

Prompt and favorable action toward the granting of this petition and the revival of the '747 application is earnestly solicited.

Dated: February 23, 2009

Respectfully submitted,

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